UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE
United States Patent and Trademark Office
Address: COMMISSIONER FOR PATENTS
P.O. Box 1450
Alexandria, Virginia 22313-1450
www.uspto.gov

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/811,675	03/19/2001	Ryoichi Imanaka	8861-402US (P24583-01)	9394

570 7590 03/23/2006

AKIN GUMP STRAUSS HAUER & FELD L.L.P.
ONE COMMERCE SQUARE
2005 MARKET STREET, SUITE 2200
PHILADELPHIA, PA 19103

EXAMINER
LE, MIRANDA

ART UNIT	PAPER NUMBER
2167	

DATE MAILED: 03/23/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

e

Office Action Summary	Application No.	Applicant(s)	
	09/811,675	IMANAKA ET AL.	
	Examiner	Art Unit	
	Miranda Le	2167	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE *3* MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133): Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

1)☒ Responsive to communication(s) filed on *03 January 2006*.

2a)☒ This action is **FINAL**. 2b)☐ This action is non-final.

3)☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

4)☒ Claim(s) *33-38* is/are pending in the application.

4a) Of the above claim(s) _____ is/are withdrawn from consideration.

5)☐ Claim(s) _____ is/are allowed.

6)☒ Claim(s) *33-38* is/are rejected.

7)☐ Claim(s) _____ is/are objected to..

8)☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

9)☐ The specification is objected to by the Examiner.

10)☐ The drawing(s) filed on _____ is/are: a)☐ accepted or b)☐ objected to by the Examiner.

Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).

11)☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

12)☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

a)☐ All b)☐ Some * c)☐ None of:

1.☐ Certified copies of the priority documents have been received.

2.☐ Certified copies of the priority documents have been received in Application No. _____.

3.☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

1) ☐ Notice of References Cited (PTO-892)
2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
3) ☒ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08) Paper No(s)/Mail Date *11/17/2005*.
4) ☐ Interview Summary (PTO-413) Paper No(s)/Mail Date. _____ .
5) ☐ Notice of Informal Patent Application (PTO-152)
6) ☐ Other: _____.

DETAILED ACTION

1. This communication is responsive to Amendment, filed 01/03/2006.

Claims 33-38 are pending in this application. Claims 33, 36 are independent claims. This action is made Final.

Claim Rejections - 35 USC § 102

2. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

> A person shall be entitled to a patent unless:
>
> (e) the invention was described in
>
> (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or
>
> (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

3. Claims 33, 36 are rejected under 35 U.S.C. 102(e) as being anticipated by Kataoka et al. (US Patent No. 5,857,021).

Kataoka anticipated independent claims 33, 36 by the following:

Kataoka teaches a recording method for recording data on a recording medium, said recording medium having a unique ID recorded thereon (i.e. A medium ID 121 is an identifier uniquely assigned to the storage medium 101, which is burned into a predetermined region in a non-rewritable manner with a laser beam, for example, col. 6, lines 64-65), the recording method comprising:

reading the unique ID (i.e. ID 121 extracted from the storage medium 101, col. 7, line 11) from the recording medium (i.e. the storage medium 101, col. 7, line 11) (col. 6, line 57 to col. 7, line 26);

encrypting the data using the unique ID (i.e. The first private key generating means 105 generates a private key, based on the medium ID 121 extracted from the storage medium 101, col. 7, lines 9-11) to generate an encrypted data (i.e. The second encrypting means 108 encrypts the data with the data encryption key 106, col. 7, lines 23-24) (col. 6, line 57 to col. 7, line 26); and

recording the encrypted data on the recording medium (i.e. writes the encrypted data into the storage medium 101 as the aforementioned encrypted data 123, col. 7, lines 24-26) (col. 6, line 57 to col. 7, line 26).

It is noted, the ID 121 extracted from the recording medium 101 is used to generate the first private key (col. 7, line 11), then the first encrypting means 107 encrypts the data encryption key 106 with the private key (col. 7, lines 18-20), and the second encrypting means 108 encrypt the data with the data encryption key 106 and writes the encrypted data into the storage medium 101 (col. 7, lines 18-20).

As per claim 36, Kataoka teaches a reproducing for reproducing data from encrypted data stored in a recording medium (see Fig. 7), said recording medium data using a unique ID recorded thereon, the reproducing method comprising:

reading the unique ID from the recording medium (i.e. the security controller 12 examines whether or not the storage medium 5 contains a medium ID, col. 5, lines 36-44, step 32 in Fig. 7);

decrypting the encrypted data using the unique ID to generate a decrypted data; (i.e. the data is decoded, or decrypted, col. 5, lines 65-66, step 37 in Fig. 7);

producing the decrypted data (i.e. The decoded data is stored in a local storage unit in the terminal, col. 6, lines 1-2, step 38 in Fig. 7).

Claim Rejections - 35 USC § 103

4. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

> (a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negatived by the manner in which the invention was made.

This application currently names joint inventors. In considering patentability of the claims under 35 U.S.C. 103(a), the examiner presumes that the subject matter of the various claims was commonly owned at the time any inventions covered therein were made absent any evidence to the contrary. Applicant is advised of the obligation under 37 CFR 1.56 to point out the inventor and invention dates of each claim that was not commonly owned at the time a later invention was made in order for the examiner to consider the applicability of 35 U.S.C. 103(c) and potential 35 U.S.C. 102(e), (f) or (g) prior art under 35 U.S.C. 103(a).

5. Claims 34, 35, 37, 38 are rejected under 35 U.S.C. 102(e) as being anticipated by Kataoka et al. (US Patent No. 5,857,021), in view of Teshima et al. (US Patent No. 6,272,470).

As to claims 34, 37, Kataoka does not explicitly teach said data is image data generated by a diagnostic instrument. However, Teshima teaches image data generated by a diagnostic instrument (i.e. diagnostic X-ray system in Fig. 1).

It would have been obvious to one of ordinary skill in the art at the time of the invention to combine the teachings of Kataoka with the teachings of Teshima to include "image data generated by a diagnostic instrument" in order to provide an electronic clinical recording system for a wide-area hospital information system enabling the whole of a region to share medical information at low cost without any concern about a difference in type of equipment.

As to claims 35, 38, Kataoka does not specifically teach said data is an electronic clinical chart. However, Teshima teaches electronic clinical chart (i.e. medical information, col. 3, lines 33-34).

It would have been obvious to one of ordinary skill in the art at the time of the invention to combine the teaching of Kataoka with the teaching of Teshima to include "an electronic clinical chart" in order to provide an electronic clinical recording system for a wide-area hospital information system enabling the whole of a region to share medical information at low cost without any concern about a difference in type of equipment.

Response to Arguments

6. Applicant's arguments filed 01/03/2006 have been fully considered but they are not persuasive.

Applicant argues that:

(a) Kataoka does not teach "encrypting the data using the unique ID to generate an encrypted data" as recited in claim 33.

(b) Kataoka does not teach "recording the encrypted the data on the recording medium" as recited in claim 33.

The Examiner respectfully disagrees for the following reasons:

Per (a), Kataoka teaches encrypting the data using the unique ID to generate an encrypted data as "The first private key generating means 105 generates a private key, based on the medium ID 121 extracted from the storage medium 101 and a unit ID 104. The unit ID 104 is a unique identifier of the computer system itself or that of a portable drive unit (e.g., an MO drive). While the former identifier is normally used as the unit ID 104, the latter may be useful in some situations such as system installation or maintenance, because it is possible to install programs, set up data, and modify data using the same drive unit and storage medium for different computer systems. The first encrypting means 107 encrypts the data encryption key 106 with the private key generated by the first private key generating means 105. The encrypted encryption key is written into the storage medium 101 as the aforementioned permission data 122. The second encrypting means 108 encrypts the data with the data encryption key 106 and writes the encrypted data into the storage medium 101 as the aforementioned encrypted data 123" (col. 7, lines 9-26).

Note that the encrypting means 108 encrypts the data with the data encryption key 106, which is generated form the medium ID 121 through the private key. Therefore, the encryption key 106 implies the medium ID 121.

Thus, the Kataoka system can not be distinguished from the claim invention since Kataoka teaches encrypting the data using the unique ID to generate an encrypted data the ID

121 extracted from the recording medium from the beginning of the method to encrypt the data (col. 7, lines 9-26).

Per (b), Kataoka teaches the encrypted data to be recorded on the medium as " writes the encrypted data into the storage medium 101 as the aforementioned encrypted data 123", (col. 7, lines 24-26).

Therefore, Kataoka does disclose each and every element recited in Applicant's claim 33. The claim language as presented is still read on by the Kataoka reference at the cited paragraph in the claim rejections.

Accordingly, the claimed invention as represented in the claims does not represent a patentable over the art of record.

Conclusion

7. **THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Miranda Le whose telephone number is (571) 272-4112. The examiner can normally be reached on Monday through Friday from 8:30 AM to 5:00 PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Jean Homere, Esq., can be reached on (571) 272-3780. The fax number to this Art Unit is 571-273-8300.

Any inquiry of a general nature or relating to the status of this application should be directed to the Group receptionist whose telephone number is (703) 305-3900.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see http://pair-direct.uspto.gov. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

Miranda Le
March 16, 2006